

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT J. KOFFRON and ROSS A. JACOBS

Appeal 2006-1217
Application 10/781,272
Technology Center 1700

Decided: September 27, 2006

Before GARRIS, PAK, and FRANKLIN, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This case is not ripe for review and is, therefore, remanded to the Examiner for appropriate action.

Any initial inquiry into the propriety of the Examiner's prior art rejections requires the determination of the scope of the claimed subject matter. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). We observe that independent claims 1, 14, and 30 on appeal recite a vortex inhibitor having, *inter alia*, mechanical elements defined by means-plus-function limitations. Claims 1 and 30 recite "a means for

orienting the refractory body in a narrow end downward position if the refractory body is misaligned, wherein the means for orienting is retained by the hollow chamber” Claim 14 recites “a means for aligning the refractory body in the metal pouring vessel during at least a portion of the metal pour without substantially obstructing the flow of molten metal through the discharge nozzle, wherein the means for aligning is retained by the hollow chamber”

When the claimed elements are defined by means-plus-function limitations, we must interpret them as being limited to the corresponding structures described in the specification and the equivalents thereof consistent with 35 U.S.C. § 112, 6th paragraph. *In re Donaldson Co.*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994)(*en banc*). The specification must disclose the corresponding structures of the claimed means-plus-function limitations in such a manner that one skilled in the art would know and understand what structures correspond to the claimed means-plus-function limitations. *Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999). The structures disclosed in the specification, for example, are considered “corresponding” to the means-plus-function limitations “if the specification or prosecution history clearly links or associates that structure to the function

Appeal 2006-1217
Application 10/781,272

recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing § 112, ¶ 6.” *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997).

According to 37 CFR § 41.37(c)(1)(v)(2004), the Appellants are required to identify “every means plus function and step plus function as permitted by 35 U.S.C. [§] 112, sixth paragraph,” and set forth “the structure, material, or acts described in the specification as corresponding to each claimed function . . . with reference to the specification by page and line number, and to the drawing, if any, by reference characters” in the Summary of Claimed Subject Matter section of their Brief. However, the Appellants have not done so.

37 CFR § 41.37(d)(2004) states that:

If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Thus, upon return of this application, the Examiner must require the Appellants to submit an amended Brief to comply with the requirements of 37 CFR § 41.37(c) (1)(v)(2004). Upon receiving the amended Brief, the Examiner must review it to determine (1) whether it meets the requirements

Appeal 2006-1217
Application 10/781,272

set forth in 37 CFR § 41.37(c)(1)(v)(2004) and (2) whether the structures disclosed in the specification are clearly defined and linked to the claimed means-plus-function limitations in compliance with 35 U.S.C. § 112, second paragraph.¹

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board. If the Examiner enters any new ground of rejection in the Supplemental Examiner's Answer, the Appellants may choose one of the two options provided in 37 C.F.R. § 41.39(b)(2004) within two months from the date of the Supplemental Examiner's Answer to "avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection."

REMANDED

¹ A quick glance of the specification reveals that the claimed means for orienting is defined inconsistently (Spec. at 9) and that the claimed means for aligning is not expressly linked to any structure in the specification (Spec. at 4-14).

Appeal 2006-1217
Application 10/781,272

*BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075*

CKP:hh